IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

INVENTOR: Anand Rangarajan et al.
CASE: P3919
SERIAL NO.: 09/550,348
GROUP ART UNIT: 2178
FILED: 04/14/2000   EXAMINER: Campbell, Joshua D.
SUBJECT: Method and Apparatus for Providing Auto-Registration and Service
             Access to Internet Sites for Internet Portal Subscribers

PARTY IN INTEREST: All inventions in the disclosure in the present case are assigned
             to or assignable to: Yodlee, Inc.com

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

APPEAL BRIEF

1.0   **Real Party in Interest**

The real party in interest is Yodlee, Inc.com

2.0   **Related Appeals and Interferences**

This is an appeal from the Office Action of the Examiner dated October 01, 2007, finally rejecting claims 1-17and 19.

3.0   **Status of the Claims**

Following is the status of all claims in the instant case:

1. Rejected - appealed in this brief; independent.
2. Rejected - appealed in this brief; dependent.
3. Rejected - appealed in this brief; dependent.
4. Rejected - appealed in this brief; dependent.
5. Rejected - appealed in this brief; dependent.
6. Rejected - appealed in this brief; dependent.
7. Rejected - appealed in this brief; dependent.
8. Rejected - appealed in this brief; dependent.
9. Rejected - appealed in this brief; independent.
10. Rejected - appealed in this brief; dependent.
11. Rejected - appealed in this brief; dependent.
12. Rejected - appealed in this brief; dependent.
13. Rejected - appealed in this brief; dependent.
14. Rejected - appealed in this brief; dependent.
15. Rejected - appealed in this brief; independent.
16. Rejected - appealed in this brief; dependent.
17. Rejected - appealed in this brief; dependent.

18. Cancelled

19. Rejected - appealed in this brief; independent.

4.0 Status of Amendments

No amendments have been filed subsequent to the rejection of claims 1-17 and 19, the subjects of this appeal.

5.0 Summary of the Claimed Subject Matter

Following is a concise explanation of the subject matter defined in each of the two standing independent claims including their dependent claims.

5.1 Independent software application claim 1

1. (Previously presented) A software application tangibly embodied on a computer-readable medium for populating and submitting interactive forms by proxy, comprising (p. 51, lines 7-9);

a function for finding and capturing data about a site associated with the form and about the form associated with the site (p. 53, lines 20-28, Reg Spy);

a function for writing an executable instruction order containing data specific to the site, the associated form, and a requesting user (p. 54, lines 15-25);

a function for navigating to the site and submitting data to a host sponsoring the site using the form associated with the site, the data including at least a request for summarized information pertinent to the user (p. 54 line 26 to p. 55 line 18);

a function for returning and recording a portion of the form-submitted data accepted by the host for subsequent use in gaining access to the site (p. 54 line 26 to p. 55

line 18);

a function for returning and recording data that is the result of the form submission (p.66, line 13-15); and

a function for user notification of data that is the result of the form submission and registration attempt (p.67, line 3-8);

characterized in that the instruction order contains all of the required instruction data for navigating to and registering the user to the site, including authentication data for secure login, if required (p. 65, lines 30-35), and further characterized in that the user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site (p. 67, lines 3-8), and the summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user (p.32 lines 7-16; p. 37, lines 4-10; p. 66 lines 9-15; Fig. 11).

In summary, the software application populates and submits interactive forms at Internet sites by proxy providing a function for finding and capturing data about a site associated with the form and about the form associated with the sit. The application uses the site and form information to write an executable instruction order containing data specific to the site, the associated form, and a requesting user. The application then navigates to the site and submits data to a host sponsoring the site using the form associated with the site, the data including at least a request for summarized information pertinent to the user. The application then returns and records a portion of the form-submitted data accepted by the host for subsequent use in gaining access to the site and also returns and records data that is the result of the form submission. The application notifies the user of data that is the result of the form submission and registration attempt. The instruction order contains all of the required instruction data for navigating to and registering the user to the site, including authentication data for secure login, if required. The user notification is sent to the user by the software application including registration status and

authentication data accepted by the hosted site, and the summarized information
pertinent to the user from the site, including links to or information from alternate
sites not solicited by, or registered to by the user.

> *For example, a user may want to know what the best available interest rate*
available to the user for a home loan. The software application may go online on
behalf of a user, register automatically at a Web site of the user's bank or mortgage
company, access current interest rates pertaining to the user, via data submission at
a Web form and, additionally, solicit a Web site not known to the user to access
interest rates that may be competitive with the rates obtained at the user's Web sites.

5.2 dependent claims 2-8

Claim 2 recites that the site is an interactive information-page located on a data-packet-network.

Claim 3 recites the site is an electronic WEB page and the data-packet-network is the Internet network.

Claim 4 recites that the form is an interactive registration form contained within the site.

Claim 5 recites that the host is a company providing a service available through the site and accessible through the form contained in the site.

Claim 6 provides an additional limitation to claim 3 wherein all of the software functions are resident in a single server-node on the Internet and are executed from the single server-node.

Claim 7 adds to claim 3 reciting that certain software functions are distributed over a

plurality of server nodes on the Internet and are executed from those server nodes.

Claim 8 adds to the software application of claim 3 wherein the instruction order is written in the form of eXtensible mark-up language.

5.3 independent system claim 9

9. (Previously presented) A hardware-software system for configuring and executing an instruction order for populating and submitting an interactive form to a host and returning data from the host comprising(p. 51, lines 7-9;);

      a portal server running configuration software for interfacing with a user and for accepting data input in the form of an order request and configuration data (Fig. 10, WS 217, p.52, lines 3-13);

      a generation server running order-writing software for generating the instruction order according to a job request initiated by the portal server (Fig. 10, IS 221, p. 57, lines 9-16);

      a navigation server running form population software for executing the instruction order received from the generation server according to instruction and data contained therein, the data including at least a request for summarized information pertinent to the user (p. 54, line 26 to p. 55 line 8); and

      a data repository accessible to the servers for recording, storing and serving data, such that a user connected to the portal server and utilizing the configuration software may obtain data about a site and about an associated interactive form, the data ultimately made available along with user data to the generation server which writes the instruction order for execution by the navigation server, and wherein accepted form-submitted data is returned by the navigation server to the data repository and recorded for subsequent access to the site; (DB 219, p. 56 lines 9-12; p. 54, line 26 to p. 55 line 8)

      characterized in that the instruction order contains all of the required instruction data for navigating to and registering the user to the site, including authentication data for

secure login if required, and further characterized in that data specific to the site, that is a result of the form submission, is notified to the user by the software portion of the system, including registration status and user authentication data accepted by the hosted site, and summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user (p.32 lines 7-16; p. 37, lines 4-10; p. 66 lines 9-15; Fig. 11).

In summary claim 9 provides a hardware, software system comprising a network of servers for interfacing with a user and for accepting data input in the form of an order request and configuration data; generating an instruction order according to a job request initiated by a portal server; executing the instruction order received from the generation server according to instruction and data contained therein, the data including at least a request for summarized information pertinent to the user. A data repository is provided and accessible to the servers for recording, storing and serving data, such that a user connected to the portal server and utilizing the configuration software may obtain data about a site and about an associated interactive form, the data ultimately made available along with user data to the generation server which writes the instruction order for execution by the navigation server, and the form-submitted data is returned by the navigation server to the data repository and recorded for subsequent access to the site.

The instruction order contains all of the required instruction data for navigating to and registering the user to the site, including authentication data for secure login if required, and data specific to the site, that is a result of the form submission, is notified to the user by the software portion of the system, including registration status and user authentication data accepted by the hosted site, and summarized information pertinent to the user from the site is provided to the user, including links to or information from alternate sites not solicited by, or registered to by the user.

5.4 dependent claims 10-14

Claim 10 provides that the host is a company maintaining an interactive information page located on a data-packet-network.

Claim 11 recites that the interactive information page of claim 10 is an electronic WEB page available on the Internet.

Claim 12 recites that the form is an interactive registration form provided in the electronic WEB page.

Claim 13 recites that the instruction order is written in eXtensible mark-up language.

Claim 14 provides the system of claim 10 wherein a separate and dedicated data network inter-connects the server-nodes for communication.

5.5 method claim 15

15. (Previously presented) A method for populating and submitting an interactive form by proxy comprising the steps of;

    (a) obtaining data specific to a form, a site, and a requesting user;

This limitation is described in the as-filed specification particularly in the paragraph beginning on page 53 at line 20, and continuing to line 28. A portal server has an instance of site configuration software, which is a first part of an auto-registration suite. The site-configuration software provides an interface to a user from which he or she may pre-configure WEB-sites for auto registration. Part of that capability includes the provision of an interactive tool known to the inventor as "Reg Spy" (not shown). The basic function of the site configuration software is to allow the user to navigate to and select (using Reg Spy) the proper URLs and forms, which will

then be used for obtaining registration to a site on behalf of the user.

(b) writing an instruction order for navigating to the site for the purpose of populating and submitting the form to a host associated with the site, the order including at least an instruction for summarized information pertinent to the user;

This limitation is described in the as-filed specification on pg. 54, lines 15-25. The site holds profile data, enterprise data, and summary data. An instance of database renderer software is provided to execute on the site. That software is adapted to allow writing to and parsing from the site according to need. Software is provided and adapted to generate a machine-readable job-order from information submitted by the user and from prior information available in the server. The software formulates a job order, which includes instruction for navigation and log-in, if required. The output of the software is a machine-readable job order that carries instruction for site-navigation and instruction for site registration purposes, as well as information to be gathered on behalf of the user from the site.

(c) executing the instruction order including a sub-execution for obtaining data from the site after successful form submission to the host sponsoring the site; wherein the instruction order contains all of the required instruction data for navigating to and registering a user to the site, including authentication data for secure login if required, and data specific to the site, that is a result of the form submission, is notified to the user by software, including registration status and user authentication data accepted by the hosted site, and summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user.

This limitation is described in the specification at pg.32 lines 7-16; and Fig. 11. If a user requests a summary about data on one of his sites such as, perhaps, current

interest rates and re-finance costs at his mortgage site, the service may at its own discretion provide an additional unsolicited summary from an alternate mortgage site for comparison. This type of summarization would be designed to enhance a user's position based on his profile information. In this case, updated data about latest interest rates, stock performances, car prices, airline ticket discounts, and so on would be stored by the service for comparative purposes. If a user request for a summary can be equaled or bettered in terms of any advantage to the user, such summary data may be included.

In summary, claim 15 recites a method for populating and submitting an interactive form by proxy comprising steps of obtaining data specific to a form, a site, and a requesting user; writing an instruction order for navigating to the site for the purpose of populating and submitting the form to a host associated with the site, the order including at least an instruction for summarized information pertinent to the user; and executing the instruction order, including a sub-execution for obtaining data from the site after successful form submission to the host sponsoring the site. The instruction order contains all of the required instruction data for navigating to and registering a user to the site, including authentication data for secure login if required, and data specific to the site, that is a result of the form submission, is notified to the user by software, including registration status and user authentication data accepted by the hosted site, and summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user.

5.6 depended claims 16-17.

Claim 16 provides an addition to step (a) of claim 15, wherein in step (a), the site is an electronic information page hosted on the Internet and the form is an electronic form located within the information page.

Claim 17 recites that the instruction order of step (b) is written in eXtensible mark-up language.

5.7 software application claim 19

19. (Previously presented) A software application tangibly embodied on a computer readable medium for populating and submitting interactive forms by proxy, comprising (P. 51, lines 7-9);

a function for finding and capturing data about a site associated with the form and about the form associated with the site (p. 53, lines 20-28 Reg Spy);

a function for writing an instruction order containing data specific to the site, the associated form, and a requesting user, the order including at least a request for summarized information pertinent to the user (p. 54, lines 15-25);

a function for navigating to the site and submitting data to a host sponsoring the site using the form associated with the site (p. 54, line 26 to p. 55, line 18; p. 66, lines 9-15);

a function for returning and recording a portion of the form-submitted data accepted by the host for subsequent use in gaining access to the site (p. 54, line 26 to p. 55, line 18);

a function for returning and recording data that is the result of the submission (p. 66, lines 13-15); and

a function for providing user notification of data that is the result of the form submission and registration attempt (p.67, line 3-8);

characterized in that the instruction order contains all of the required instruction data for navigating to and registering a user to the site, including authentication data for secure login, if required, and further characterized in that the user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site, and summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user (p. 65, lines 30-35 p. 67; lines 3-8; p.32 lines 7-16; p. 37, lines 4-10; p. 66 lines 9-15; Fig. 11).

In summary, the software application populates and submits interactive forms at Internet sites by proxy providing a function for finding and capturing data about a site associated with the form and about the form associated with the sit. The application uses the site and form information to write an executable instruction order containing data specific to the site, the associated form, and a requesting user. The application then navigates to the site and submits data to a host sponsoring the site using the form associated with the site, the data including at least a request for summarized information pertinent to the user. The application then returns and records a portion of the form-submitted data accepted by the host for subsequent use in gaining access to the site and also returns and records data that is the result of the form submission. The application notifies the user of data that is the result of the form submission and registration attempt. The instruction order contains all of the required instruction data for navigating to and registering the user to the site, including authentication data for secure login, if required. The user notification is sent to the user by the software application including registration status and authentication data accepted by the hosted site, and the summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user.

For example, a user may want to know what the best available interest rate available to the user for a home loan. The software application may go online on behalf of a user, register automatically at a Web site of the user's bank or mortgage company, access current interest rates pertaining to the user, via data submission at a Web form and, additionally, solicit a Web site not known to the user to access interest rates that may be competitive with the rates obtained at the user's Web sites.

6.   Grounds of Rejection to be Reviewed on Appeal

Claims 1-17 and 19 remain rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Claims 1-6, 15-16, and 19 remain rejected

under 35 U.S.C. 103(a) as being unpatentable over Light et al. (hereinafter Light, US

Patent Number 6,192,380, filed on March 31, 1998) in view of Burson et al. (hereinafter

Burson, US Patent Number 6,405,245, US filing date of October 28, 1998). Claim 7, 9-

12, and 14 remain rejected under 35 U.S.C; 103(a) as being unpatentable over Light et al.

(hereinafter Light, US Patent Number 6,192,380, filed March 31, 1998) in view of

Burson et al. (hereinafter Burson, US Patent Number 6,405,245, US filing date of

October 28, 1998) as applied to claims I and 3 above, and further in view of Jacobs et al.

(US Patent Number 5,611 ,048, issued on March 11, 1997).

7.   Argument

Following is a presentation of arguments against the rejection put forth by the

Examiner and responded to by Appellant.

7.1 35 U.S.C. 112 against claims 1-17 and 19

The Examiner's Arguments:

The Examiner argues that; "Having the user request to view summary information

for the site after the registration process for that site is complete before being able to add

summary information from non-solicited sites or sites the user is not registered to is

critical or essential to the practice of the invention, but not included in the claim(s) is not

enabled by the disclosure. See In re Mayhew, 527 F.2d 1229, 188 USPQ 356 (CCPA

1976). The final limitation in the independent claims states that the registration

notification of the independent claims now includes, "... summarized information

pertinent to the user from the site, including links to or information from alternate sites

not solicited by, or registered to by the user," which is not enabled by the specification

without taking steps prior to supplying this user with this information. The specification

does not assert that the registration notification could include this additional information,

rather the specification discloses specifically "...if a user requests summary about data on

one of his sites such as, perhaps, current interest rates and refinance costs at his mortgage

site, the service may at its own discretion provide an additional unsolicited summary from an alternate mortgage site for comparison," (page 32 lines 7-16 of applicant's specification) as a basis for when to provide unsolicited summaries. It is noted that this statement requires that the registration process for the site must have been completed and that a separate request for data must be generated to view summaries, at which point the summary data of unsolicited sites may be added to the output document. However, the claim states that as a part of the registration process, i.e. the notification that registration has completed, is where this data is presented even though the specification is silent to this fact. Additional information on providing unsolicited summaries is provided by that applicant in the specification (page 37, line 26-page 38, line 6 of applicant's specification) however, just as earlier in the specification the summary data is not included as part of a notification of registration. The applicant must either correct the claims to enable them or specifically point out where in the specification this limitation can be properly drawn, a mere allegation that the limitations as presented are enabled will not be enough to overcome this rejection.

In an effort to correct the lack of enablement detailed above, the applicant has amended the independent claims accordingly, "... a function for navigating to the site and submitting data to a host sponsoring the site using the form associated with the site, the data including at least a request for summarized information pertinent to the user," however this new amendment also lacks enablement according to the specification. The limitation explicitly states, ".. . submitting data to a host sponsoring the site using the form associated with the site," this form being a registration form for registering the user to the site. At no point in the specification does the applicant provide any support for making requests for summary data via registration forms, mainly because the registration forms do not support data requests, rather they are used to allow registration to a site. The data that is submitted to the site via a form is for registration purposes only as detailed in the specification, thus it is not enabled to include a request for summarized information. The applicant must either correct the claims to enable them or specifically point out where in the specification this limitation can be properly drawn, a mere allegation that

the limitations as presented are enabled will not be enough to overcome this rejection.

Appellant's response:

Appellant points out the Examiner's main argument is that applicant's claimed limitation reciting "... summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user," is not enabled by the specification without taking steps prior to supplying this user with this information. The specification does not assert that the registration notification could include this additional information, rather the specification discloses specifically "...if a user requests summary about data on one of his sites such as, perhaps, current interest rates and refinance costs at his mortgage site, the service may at its own discretion provide an additional unsolicited summary from an alternate mortgage site for comparison," (page 32 lines 7-16 of applicant's specification) as a basis for when to provide unsolicited summaries. It is noted that this statement requires that the registration process for the site must have been completed and that a separate request for data must be generated to view summaries, at which point the summary data of unsolicited sites may be added to the output document.

Applicant's independent claims clearly recite (emphasis added):

a function for writing an executable instruction order containing data specific to the site, the associated form, and a requesting user (p. 54, lines 15-25);

a function for navigating to the site and submitting data to a host sponsoring the site using the form associated with the site, the data including at least a request for summarized information pertinent to the user (p. 54 line 26 to p. 55 line 18);

a function for returning and recording data that is the result of the form submission (p.66, line 13-15); and

a function for **user notification of data that is the result of the form submission** and registration attempt (p.67, line 3-8);

characterized in that user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site (p. 67, lines 3-8), **and** the summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user (p.32 lines 7-16; p. 37, lines 4-10; p. 66 lines 9-15; Fig. 11).

Applicant's claims do not limit the form to a "registration form" as espoused by the Examiner. Applicant's claims include software/hardware for negotiating forms for registration and returning summary data as a result of data submission in said forms. Applicant points out that the claims do not limit the user notification to "Registration notification" but notification of data that is the result of the form submission. Applicant does not believe it is proper for the Examiner to assert more limitations into applicant's claim language than what is actually present when performing the examination procedure.

Further, applicant's specification clearly teaches and supports all of the claimed subject matter in claims 1-17 and 19 as follows:

"Alternatively, if a user requests a summary about data on one of his sites such as, perhaps, current interest rates and re-finance costs at his mortgage site, the service may at its own discretion provide an additional unsolicited summary from an alternate mortgage site for comparison. This type of summarization would be designed to enhance a user's position based on his profile information. In this case, updated data about latest interest rates, stock performances, car prices, airline ticket discounts, and so on would be stored by the service for comparative purposes. If a user request for a summary can be equaled or bettered in terms of any advantage to the user, **such summary data may be included** (pg. 32 lines 7-16)."

Applicant points out that the last sentence of this paragraph clearly states that summary data of unsolicited sites may be included with the requested summary data from the user's site.

"Fig. 6 is a logical flow chart illustrating an exemplary summarization process performed by the software agent of Fig. 4 in a User-independent smart mode with minimum or no user input. In step 117 an enterprise-initiated summary process begins. In this case, the enterprise may be assisting a user in finding a better deal or, perhaps presenting the individual with summaries from and links to alternative pages not yet subscribed to by a user ." (pg. 37, lines 4-10)

Application points out that summaries from alternative sites not yet subscribed to by the user may include links, as claimed. This can reasonably be interpreted as the unsolicited sites as recited in applicant's claims. Further, Fig. 6 clearly recites that automatic log-in on behalf of a user and data summarization occur in one process with one summary presented to the user which is a result of the registration/data gathering process.

A data return module 265 is provided to return successful registration information including user notification thereof and record of successful and accepted values submitted for future log-in purposes. In some cases, accepted values may be immediately used by the service to login on behalf of a user and to obtain data from the site for a user if directed to do so by XML order (pg. 67 lines 3-8).

Applicant contends that the specification teaches that summary data from the site may be immediately obtained upon acceptance of the user's registration process according to XML order. The XML order can reasonably be interpreted as the instruction order of applicant's claims.

A user notification module 267 is provided within layer 237 and adapted to notify a user upon successful registration and in some cases failed registration attempts. It may be that a site disqualifies a particular user from registration based on information such as credit rating or some other criteria. In this event, a notice would be sent to the user. A user presentation module 273 is provided and adapted to present **any** summary or refresh data to a user if it was requested **before registration.** Such data may be returned along

with registration confirmation and log-in data. Module 273 is also used during normal summary gathering operations after registration and inclusion of the target site into a user's list of registered sites.

Here we see a user notification module 267 is introduced. Applicant points out that the data return module presented above on pg. 63 teaches the inclusion of user notification; the user notification module is simply introduced here. Also, the specification clearly reads that summary information may be requested before registration, so the Examiner's argument that steps of the process are missing in the specification are moot. If we look back on the disclosure presented for pg. 32, the unsolicited information may be included with initial summary information.

Applicant argues that the specification clearly supports the claim language of applicant's invention. Therefore, appellant respectfully requests the 112 rejection be withdrawn.

7.2 35 U.S.C. 103 against claims 1-6, 15-16, and 19.

The Examiner's Arguments Regarding Independent Claim 1:

Regarding independent claim 1, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48- column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site, which could include information such as an authentication password (column 3, line 30-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's

form data (column 4, lines 5-36 of Light). Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user. However, Burson discloses a method in which a user notification is returned from P1 engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible P1) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Burson because it would have allowed the user to track transaction results with all sites.

Appellant's response:

The Examiner admits that Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user. However, the Examiner continues, Burson discloses a method in which a user notification is returned from P1 engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible P1) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson).

Applicant points out that the actual text of applicant's claim limitation recites; "and further characterized in that the user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site, and the summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user."

Applicant argues that all PI (private information pertaining to the user) providers in Burson are known Web sites of the user providing proprietary information to the user. Burson specifically teaches:

""Personal Information" is all of the data that companies, information providers, have that is specific or unique to each person such as monthly bills, bank account balances, investments information, health care benefits, email, voice and fax messages, 401(k) holdings or potentially any other information pertinent to a particular end user." (col. 4, lines 29-35)

Applicant argues that the PI providers in Burson are clearly registered to previously by the user or at the least, solicited by the users. In light of the detailed arguments given above regarding the 112 rejection, appellant believes the Examiner must withdraw the 112 rejection and fully consider and give patentable weight to said limitation reciting; "the user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site, and the summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user." Appellant argues the art of Burson and Light, either singly or in combination, fails to teach said limitation.

Regarding claims 2-4, 5, 6

Appellant believes dependent claims 2, 3, 4, 5 and 6 are patentable at least as depended upon patentable independent claim 1.

Examiner's rejection of claim 15

Regarding independent claim 15, the claim incorporates substantially similar subject matter as claim 1. Thus the claim is rejected along the same rationale as claim 1.

Appellant's Response

Because the Examiner relies on the same rational for the rejection of claim 15 as given on behalf of claim 1, Appellant believes claim 15 is patentable for the same reasoning provided by Appellant on behalf of claim 1, above.

Regarding claim 16

Appellant believes dependent claim 16 is patentable at least as depended upon patentable independent claim 1.

Examiner's rejection of claim 19

Regarding independent claim 19, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48- column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site, which could include information such as an authentication password (column 3, line 30-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light). Light discloses a method in which the system stores new form information obtained from a site once the form filling process is complete (column 4, lines 5-36 of Light). Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user. However, Burson discloses a method in which a user notification is returned from P1 engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all

possible accessible P1) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Burson because it would have allowed the user to track transaction results with all sites.

Appellant's response

The Examiner admits that Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user. However, the Examiner continues, Burson discloses a method in which a user notification is returned from P1 engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible P1) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson).

Applicant points out that the actual text of applicant's claim limitation recites; "and further characterized in that the user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site, and the summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user."

Applicant argues that all PI (private information pertaining to the user) providers in Burson are known Web sites of the user providing proprietary information to the user. Burson specifically teaches:
""Personal Information" is all of the data that companies, information providers, have that is specific or unique to each person such as monthly bills, bank account balances, investments information, health care benefits, email, voice and fax messages, 401(k) holdings or potentially any other information pertinent to a particular end user." (col. 4, lines 29-35)

Applicant argues that the PI providers in Burson are clearly registered to previously by the user or at the least, solicited by the users. In light of the detailed arguments given above regarding the 112 rejection, appellant believes the Examiner must withdraw the 112 rejection and fully consider and give patentable weight to said limitation reciting; "the user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site, and the summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user." Appellant argues the art of Burson and Light, either singly or in combination, fails to teach said limitation.

Regarding Examiner's rejection of claims 7, 9-12 and 14

Examiner's rejection of claim 9

Regarding independent claim 9, Light discloses a method in which a form recognition unit detects properties about a form and a website containing a form (column 2, line 63-column 3, line 47 of Light). A matching unit then decides what data should be place in the form and at what locations, at which point the data and instructions on what to do with it (job order) is sent to the fill-in unit (column 3, line 48- column 4, line 30 of Light). The job order is an instruction that is executable by the fill-in unit and the instruction includes data necessary to navigate to and register (fill-in the form) to a site, which could include information such as an authentication password (column 3, line 30-column 4, line 30). The fill-in unit then submits the data into the form and ultimately submits the form to the host (column 3, line 48-column 4, line 30 of Light). Then, any new form information necessary for the site is added to the database containing a user's form data (column 4, lines 5-36 of Light). Light does not disclose a method in which user notification is returned to the user that includes the result of the form submission and registration attempt, including registration status, authentication data, summary information including information from alternate sites not registered to by the user.

However, Burson discloses a method in which a user notification is returned from P1 engine, which includes the results of the form submission, registration status and authentication data, and information from alternate sites not yet registered (list of all possible accessible P1) to by the user (column 6, line 66-column 7, line 17 and column 8, line 1-column 9, line 17 of Burson). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Light with the method of Burson because it would have allowed the user to track transaction results with all sites.

However, Jacobs et al. discloses that functions to be performed on a server can be divided across multiple servers (column 4, lines 9-17 of Jacobs et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Light and Burson with the method of Jacobs et al. because it would have optimized the efficiency of the method of Light by splitting the workloads among multiple servers.

Appellant's Response

As previously argued by appellant on behalf of claims 1 and 15, above, Appellant points out that the actual text of applicant's claim limitation recites; "and further characterized in that the user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site, and the summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user."

Applicant argues that all PI (private information pertaining to the user) providers in Burson are known Web sites of the user providing proprietary information to the user. Burson specifically teaches:

""Personal Information" is all of the data that companies, information providers, have that is specific or unique to each person such as monthly bills, bank account balances, investments information, health care benefits, email, voice and fax messages, 401(k)

holdings or potentially any other information pertinent to a particular end user." (col. 4, lines 29-35)

Applicant argues that the PI providers in Burson are clearly registered to previously by the user or at the least, solicited by the users. In light of the detailed arguments given above regarding the 112 rejection, appellant believes the Examiner must withdraw the 112 rejection and fully consider and give patentable weight to said limitation reciting; "the user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site, and the summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user." Appellant argues the art of Burson, Jacobs and Light, either singly or in combination, fails to teach said limitation.

Regarding claims 7, 10-12 and 14
Appellant believes dependent claims 7, 10-12 and 14 are patentable at least as depended upon patentable independent claim.

Regarding Examiner's rejection of claims 8, 13 and 17
7. Claims 8, 13, and 17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Light et a!. (hereinafter Light, US Patent Number 6,192,380, filed March 31, 1998) in view of Burson et al. (hereinafter Burson, US Patent Number 6,405,245, US filing date of October 28, 1998) as applied to claims 1, 3, 9, 10, and 15 above, and further in view of Kraft et at. (US Patent Number 6,084,585, with US filing date of December 5, 1997). Regarding dependent claims 8, 13, and 17, neither Light nor Burson disclose a method in which the job order is written in XML. However, Kraft et a!. discloses that executable instructions which can be thought of as job orders can be written in any programming language including XML (column 3, lines 35-40 of Kraft et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have

combined the methods of Light and Burson with the method of Kraft et al. because the use of different programming languages was interchangeable.

Appellant's response

Appellant believes dependent claims 8, 13 and 17 are patentable at least as depended upon patentable independent claim.

Appellant strongly believes that all of the claims standing are clearly and unarguably patentable over the art presented by the Examiner. Accordingly, appellant respectfully requests that the Board reverse the rejection of the claims and hold the claims allowable.

8.   Claims Appendix

The claims involved in the appeal are:

1. (Previously presented) A software application tangibly embodied on a computer-readable medium for populating and submitting interactive forms by proxy, comprising;

   a function for finding and capturing data about a site associated with the form and about the form associated with the site;

   a function for writing an executable instruction order containing data specific to the site, the associated form, and a requesting user;

   a function for navigating to the site and submitting data to a host sponsoring the site using the form associated with the site, the data including at least a request for summarized information pertinent to the user;

   a function for returning and recording a portion of the form-submitted data accepted by the host for subsequent use in gaining access to the site;

   a function for returning and recording data that is the result of the form submission; and

   a function for user notification of data that is the result of the form submission and registration attempt;

   characterized in that the instruction order contains all of the required instruction data for navigating to and registering the user to the site, including authentication data for secure login, if required, and further characterized in that the user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site, and the summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user.

2. (Original) The software application of claim 1 wherein the site is an interactive information-page located on a data-packet-network.

3. (Original) The software application of claim 2 wherein the site is an electronic WEB page and the data-packet-network is the Internet network.

4. (Original) The software application of claim 2 wherein the form is an interactive registration form contained within the site.

5. (Original) The software application of claim 4 wherein the host is a company providing a service available through the site and accessible through the form contained in the site.

6. (Original) The software application of claim 3 wherein all of the software functions are resident in a single server-node on the Internet and are executed from the single server-node.

7. (Original) The software application of claim 3 wherein certain software functions are distributed over a plurality of server nodes on the Internet and are executed from those server nodes.

8. (Previously presented) The software application of claim 3 wherein the instruction order is written in the form of eXtensible mark-up language.

9. (Previously presented) A hardware-software system for configuring and executing an instruction order for populating and submitting an interactive form to a host and returning data from the host comprising;

      a portal server running configuration software for interfacing with a user and for accepting data input in the form of an order request and configuration data;

      a generation server running order-writing software for generating the instruction order according to a job request initiated by the portal server;

a navigation server running form population software for executing the instruction order received from the generation server according to instruction and data contained therein, the data including at least a request for summarized information pertinent to the user; and

a data repository accessible to the servers for recording, storing and serving data, such that a user connected to the portal server and utilizing the configuration software may obtain data about a site and about an associated interactive form, the data ultimately made available along with user data to the generation server which writes the instruction order for execution by the navigation server, and wherein accepted form-submitted data is returned by the navigation server to the data repository and recorded for subsequent access to the site;

characterized in that the instruction order contains all of the required instruction data for navigating to and registering the user to the site, including authentication data for secure login if required, and further characterized in that data specific to the site, that is a result of the form submission, is notified to the user by the software portion of the system, including registration status and user authentication data accepted by the hosted site, and summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user.

10. (Original) The hardware-software system of claim 9 wherein the host is a company maintaining an interactive information page located on a data-packet-network.

11. (Original) The hardware-software system of claim 10 wherein the interactive information page is an electronic WEB page available on the Internet.

12. (Original) The hardware-software system of claim 11 wherein the form is an interactive registration form provided in the electronic WEB page.

13. (Previously presented) The hardware-software system of claim 12 wherein the

instruction order is written in eXtensible mark-up language.

14. (Original) The hardware-software system of claim 10 wherein a separate and dedicated data network inter-connects the server-nodes for communication.

15. (Previously presented) A method for populating and submitting an interactive form by proxy comprising the steps of;

(a) obtaining data specific to a form, a site, and a requesting user;

(b) writing an instruction order for navigating to the site for the purpose of populating and submitting the form to a host associated with the site, the order including at least an instruction for summarized information pertinent to the user; and

(c) executing the instruction order including a sub-execution for obtaining data from the site after successful form submission to the host sponsoring the site;

wherein the instruction order contains all of the required instruction data for navigating to and registering a user to the site, including authentication data for secure login if required, and data specific to the site, that is a result of the form submission, is notified to the user by software, including registration status and user authentication data accepted by the hosted site, and summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user.

16. (Previously presented) The method of claim 15 wherein in step (a), the site is an electronic information page hosted on the Internet and the form is an electronic form located within the information page.

17. (Previously presented) The method of claim 15 wherein in step (b), the instruction order is written in eXtensible mark-up language.

18. (Canceled)

19. (Previously presented) A software application tangibly embodied on a computer readable medium for populating and submitting interactive forms by proxy, comprising;

a function for finding and capturing data about a site associated with the form and about the form associated with the site;

a function for writing an instruction order containing data specific to the site, the associated form, and a requesting user, , the order including at least a request for summarized information pertinent to the user;

a function for navigating to the site and submitting data to a host sponsoring the site using the form associated with the site;

a function for returning and recording a portion of the form-submitted data accepted by the host for subsequent use in gaining access to the site;

a function for returning and recording data that is the result of the submission; and

a function for providing user notification of data that is the result of the form submission and registration attempt;

characterized in that the instruction order contains all of the required instruction data for navigating to and registering a user to the site, including authentication data for secure login, if required, and further characterized in that the user notification is sent to the user by the software application and includes registration status and authentication data accepted by the hosted site, and summarized information pertinent to the user from the site, including links to or information from alternate sites not solicited by, or registered to by the user.

9.   **Evidence Appendix**

No evidence other than the arguments and facts presented in this brief is provided.

10.   **Related Proceedings Appendix**

The present Appeal is the first Appeal submitted to the Board.

Respectfully Submitted,
Anand Rangarajan et al.

By */Donald R. Boys/*
Donald R. Boys
Reg. No. 35,074

Central Coast Patent Agency, Inc.
3 Hangar Way, Suite D
Watsonville, CA 95076
831-768-1755